



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,372	04/12/2004	George J. Hobbs	5724-001	2828

25184 7590 05/24/2007
WILLIAM J. MASON
MACCORD MASON PLLC
POST OFFICE BOX 1489
WRIGHTSVILLE BEACH, NC 28480

EXAMINER

SAFARI, MICHAEL

ART UNIT	PAPER NUMBER
----------	--------------

3673

MAIL DATE	DELIVERY MODE
-----------	---------------

05/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/822,372	Applicant(s) HOBBS, GEORGE J.	
	Examiner M. Safavi	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,21,22,24-26 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicant's election without traverse of the invention of the species of Fig. 7, with Applicant having indicated claims 1, 3-5, 21-26, and 30 as reading upon the elected species, in the reply filed on January 31, 2007 is acknowledged. It has been noted that Applicant lists claim 23 as reading upon Fig. 7 when the invention defined by the language of claim 23 does not read upon the elected embodiment of Fig. 7. Rather, the language of claim 23 serves to read upon the embodiment of Fig. 8 or Fig. 1/8. Therefore, claim 23 will be withdrawn from further consideration along with claims 6 and 27-29.

Claims 6, 23, and 27-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of the invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 31, 2007.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-5, 21, 22, 24-26, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

Art Unit: 3673

application was filed, had possession of the claimed invention. The specification as originally filed does not appear to present a clear and complete description of an "open top" form as now appears in each of claims 1, 24, and 30. It is not clear as to what is being defined by the recitation "open top concrete form".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5, 21, 22, 24-26, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 1, it is not clear as to what is being defined by "open-top concrete form". The specification does not appear clear and complete as to an "open-top concrete form". Line 5, "the desired pad thickness" lacks antecedent basis within the claim. Therefore, it is not clear as to what "the desired pad thickness" refers. Further, Lines 4-5 of claim 1 appear to define the claimed form in terms of an element which has not been positively introduced within the claim language. Therefore, it is not clear as to what "having...a length substantially equal to the desired pad thickness" defines since a concrete pad does not form part of the invention.

Claim 24, line 1, it is not clear as to what is being defined by "open-top form". The specification does not appear clear and complete as to an "open-top form".

Claim 30, line 1, it is not clear as to what is being defined by "open-top form". The specification does not appear clear and complete as to an "open-top form". Line 5, "the

desired pad thickness" lacks antecedent basis within the claim. Therefore, it is not clear as to what "the desired pad thickness" refers. Further, Lines 4-5 of claim 30 appear to define the claimed form in terms of an element which has not been positively introduced within the claim language. Therefore, it is not clear as to what "having...a length substantially equal to the desired pad thickness" defines since a concrete pad does not form part of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 21, 22, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman '525.

As for **claims 1 and 24**, Coleman discloses an "open top" polymer form 10 comprising a plurality of spaced, vertically aligned conduits 20, 22, 24, 26 having upper ends with spacers, (36 between each conduit), connecting the conduits, the ends 28, 30, 32, 34, of the form 10 constituting the sidewalls with Fig. 1 showing a rectangular shape. Coleman does not specifically set forth removable caps covering the conduit upper ends of the conduits 20, 22, 24, 26. However, Fig. 8d and col. 4, lines 47-49 of Coleman teach utilization of caps 86 covering conduits prior to final use of the form 10.

Art Unit: 3673

And, col. 4, line 15 of Coleman teaches utilization of a cap 73 to close conduit 72 prior to final use. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the Coleman form of Fig. 1 with caps at the upper end thereof so as to inhibit any material such as debris, as taught by either of col. 4, lines 47-49 and col. 4, line 15 of Coleman. As to **claim 1**, the Coleman '525 conduits possess a length and thus, meet the recitation of "having...a length substantially equal to said given thickness".

As for **claims 3 and 21**, forming the polymer Coleman form of a thermoplastic material such as a polyvinylchloride, thus taking advantage of such an old and well known material in the building art, would have constituted a further obvious to one having ordinary skill in the art at the time the invention was made.

As for **claim 4**, the form is of a rectangular shape with side 28, 30 and end 32, 34 walls.

As for **claims 22 and 24**, forming the Coleman mold of a shape having two rows of conduits, thus "arrayed in a rectangular or diamond shape", for the purpose of providing a thicker wall as well as for versatile, multiple conduit placement, would have been obvious to one having ordinary skill in the art at the time the invention was made particularly, since it is well established that mere duplication of parts has no patentable significance unless a new and unexpected result is produced, *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

As for **claim 25 and 26**, taking into consideration dimensions 'C' and 'D' of Coleman, the Coleman conduits 20, 22, 24, 26 possess a cross-sectional area "of from

Art Unit: 3673

about 0.25 to about 2.0 inches". And, the Coleman form would include "about 4 to about 100 conduits per square foot of form".

Claims 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman '525 as applied to claims 1, 3, 4, and 6 above, and further in view of De Zen '620.

De Zen '620 teaches utilization of thermoplastic material for use in a structural form, col. 2, lines 40-41. Therefore, to have formed the modified Coleman form of a thermoplastic polymer, thus taking advantage of such an old and well known material in the building art, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by De Zen '620.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman '525 as applied to claims 1, 3, 4, and 6 above, and further in view of any of Dirksing, Hasty, Narva, Goth and Szabo.

Coleman '525 as modified fails to disclose caps having pull-tabs to assist in removal of the caps from the conduits 20, 22, 24, 26. However, each of Hasty, Narva, Goth and Szabo disclose, as conventional, pull-tabs, 1c of Fig. 1 of Dirksing, 12/14/16 of Hasty, 24 of Narva, 11/21 of Goth, and col. 1, line 46 of Szabo. Therefore, to have formed the modified Coleman form 10 with caps 86 integral with the conduits 20 22, 24, 26 and possessing pull tabs, thus allowing easy removal thereof while providing a cap secured in place prior to final use of the form, would have been obvious to one having

Art Unit: 3673

ordinary skill in the art at the time the invention was made as taught by any of Dirksing, Hasty, Narva, Goth and Szabo.

Claims 1, 3, 4, 21, 22, and 24-26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hargett '177 in view of Coleman '525.

Hargett discloses, Figs. 2-4, a polymer form 10 comprising a plurality of spaced, vertically aligned conduits 16 having upper ends with spacers, (upper portions of 12, 14), connecting the conduits, the ends of the form 10 constituting the sidewalls with Fig. 4 showing a rectangular shape. Hargett does not specifically set forth removable caps covering the conduit upper ends. The floor of Hargett lies along the lower portions, (lower surface) of 12 and 14 with such floor extending upwardly to form the conduits 16 and spacers, (upper portions of 12, 14).

However, Coleman teaches utilization of caps covering conduits during concrete pour forming so as to prevent concrete from entering the conduit during the pour.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the Hargett form with caps so as to inhibit concrete from entering the conduit as taught by Coleman.

As for **claims 25 and 26**, forming the Hargett '177 conduits 16 with a cross-sectional area "of from about 0.25 to about 2.0 inches", thus serving to allow for drainage while not appreciably interrupting with the surface of the concrete pavement, would have been obvious to one having ordinary skill in the art at the time the invention was made. Further, forming the Hargett '177 form with the conduits 16 spaced so as to

include "about 4 to about 100 conduits per square foot of form", thus serving to allow for appropriate drainage depending upon, for example, average rainfall of a particular region, would have constituted a further obvious expedient to one having ordinary skill in the art at the time the invention was made.

Claims 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hargett '177 in view of Coleman '525 as applied to claims 1-4 and 6 above, and further in view of Rothberg '314.

To have formed the modified Hargett form of a thermoplastic polymer, thus providing a light weight, low cost material, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Rothberg at col. 4, line 63.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hargett '177 in view of Coleman '525 as applied to claims 1-4 and 6 above, and further in view of Reyneveld '345.

Hargett discloses ends of the form 10 which would constitute the sidewalls with Fig. 4 showing a rectangular shape. In any event, Hargett, as modified, does not specifically set forth a border form perimeter for holding poured concrete in place while forming the resulting slab structure.

However, Reyneveld teaches, Fig. 1, application and utilization of an outer perimeter form 10 serving to contain concrete 12. Therefore to have utilized an outer

Art Unit: 3673

perimeter form serving to contain the modified Hargett concrete particularly during placement thereof, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Reyneveld.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hargett '177 in view of Coleman '525 as applied to claims 1, 3, 4, 21, 22, and 24-26, and 30 above, and further in view of any of Dirksing '886, Hasty '334, Narva '435, Goth '618 and Szabo '232.

Hargett as modified by either of Stolz and Harbeke fails to disclose pull-tabs to assist in removal of the caps from the conduits. However, each of Hasty, Narva, Goth and Szabo disclose, as conventional, pull-tabs, 1c of Fig. 1 of Dirksing, 12/14/16 of Hasty, 24 of Narva, 11/21 of Goth, and col. 1, line 46 of Szabo. Therefore, to have formed the modified Hargett '177 form with caps possessing pull tabs, thus allowing easy removal thereof, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by any of Dirksing, Hasty, Narva, Goth and Szabo.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

Art Unit: 3673

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MICHAEL SAFAVI
PATENT EXAMINER
ART UNIT 3673

M. Safavi
April 10, 2007